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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: : GROUP ART UNIT: 1634

Minako HIJIKATA, et al.

SERIAL NO.: 09/813,990 : EXAMINER: Arun K. CHAKRABARTI

FILED: March 22, 2001

FOR: GENETIC POLYMORPHISM OF MXA PROTEIN AND USE THEREOF



RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON D.C. 20231

SIR:

Responsive to the Official Action dated May 6, 2002, Applicants elect, with traverse, Group I, Claims 1-5, 11, 12, and 15, drawn to a polynucleotide, for further prosecution.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 1-5, 11, 12, and 15; drawn to a polynucleotide;

Group II: Claims 6-10, drawn to a method of sequencing;

Group III: Claims 13, 14, and 16; drawn to a method of using; and

Group IV: Claim 17; drawn to a transgenic animal.

Applicants elect, with traverse, Group I, Claims 1-5, 11, 12, and 15, drawn to a polynucleotide, for further prosecution.

The Office has characterized the inventions of Groups I-II as "unrelated." Citing MPEP §806.04 and §808.01, the Office concludes that the Groups are distinct inventions because they "are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects." Applicants traverse the Restriction Requirement on the ground that the Office merely states a conclusion while failing to show any support that the inventions of Groups I-II are "unrelated". Therefore, the Office merely states a conclusion lacking support. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

The Office has characterized the inventions of Groups I and III as related as "a product and process of use." The Office states that the claimed polynucleotides of Group I can be used in the method of treatment of Group III or can be used for nucleic acid hybridization assay or can be used to make RNA and proteins." However, there is no evidence of record to show that the "other methods" are "materially different" than the process of Group III. Therefore, the Office merely states many conclusions lacking support. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

The Office has characterized the inventions of Group I and Group IV as related as combination and subcombination. Citing MPEP §806.05(c) the Office suggests that the " the combination as claimed does not require the particulars of the subcombination as claimed because the claim refers to preparation of the pigment only. The subcombination has separate utility such as nucleic acid hybridization assay or gene therapy or synthesis of RNA as well as proteins". However, the Office has not provided sufficient reasons and/or examples to

support this assertion. Further, the Office has not shown how this "separate utility" is "materially different" than that of Group IV. The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

The Office has characterized the inventions of Groups II and III-IV as "unrelated." Citing MPEP §806.04 and §808.01, the Office concludes that the Groups are distinct inventions because they "are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects." Applicants traverse the Restriction Requirement on the ground that the Office merely states a conclusion while failing to show any support that the inventions of Groups II and III-IV are "unrelated". Therefore, the Office merely states a conclusion lacking support. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

The Office has characterized the inventions of Groups III-IV as "unrelated." Citing MPEP §806.04 and §808.01, the Office concludes that the Groups are distinct inventions because they "are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects." Applicants traverse the Restriction Requirement on the ground that the Office merely states a conclusion while failing to show any support that the inventions of Groups III-IV are "unrelated". Therefore, the Office merely states a conclusion lacking support. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

Applicants further traverse the Restriction Requirement on the additional ground that a search of all the claims would not impose a serious burden on the Office. The MPEP in §803 states as follows:

> "If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. Applicants respectfully point out that thousands of U.S. patents have issued in which many more subclasses are searched, and the Office cannot reasonably assert that a burden exists in searching these subclasses.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

For the reasons set forth above, Applicants contend that the Restriction Requirement is improper and should be withdrawn.

Applicants further submit that this application is in condition for examination on the merits and an early notification to that effect is earnestly solicited.

Respectfully submitted,

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